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AT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Ronald P. Sansone et al.

Serial No.: 10/673,794

Filed: September 30, 2003



) Attorney Docket No.: F-729

) Group Art Unit: 2636

) Examiner: Jennifer A. Stone

) Date: December 8, 2005

Title: **METHOD FOR POSTAGE EVIDENCING FOR THE PAYMENT OF TERMINAL DUES
USING RADIO FREQUENCY IDENTIFICATION TAGS**

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on July 26, 2005, and the November 28, 2005, Notification of Non-Compliant Brief.

The fee for filing for the Appeal Brief has already been paid on March 8, 2002.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

A duplicate copy of this transmittal is enclosed for use in charging the Deposit Account.

Respectfully submitted,

A handwritten signature in cursive script that reads "Ronald Reichman".

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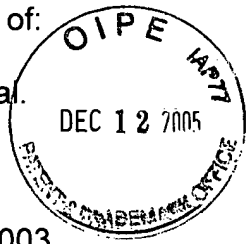
December 8, 2005
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In re patent application of:

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Title: **METHOD FOR POSTAGE EVIDENCING FOR THE PAYMENT OF
TERMINAL DUES USING RADIO FREQUENCY IDENTIFICATION
TAGS**

CORRECTED APPELLANT'S BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on, August 25, 2005, and the November 28, 2005, Notification of Non-Compliant Brief.

This brief is transmitted in triplicate.

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I. REAL PARTY IN INTEREST

Pitney Bowes Inc. is the real party in interest by way of assignment from the Appellant.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

- A) Claims 1-6 and 8-13 are in the application.
- B) Claims 1-6 and 8-13 are rejected.
- C) Claims 1-6 and 8-13 are on appeal.

IV. STATUS OF AMENDMENTS

An Amendment was filed on May 5, 2005, which was finally rejected on June 30, 2005.

V. SUMMARY OF INVENTION

A. Background

The prior art does not disclose a method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, that involved the affixing of a radio frequency identification tag to mail for the payment of the carrier fees for the first country; and the second country so that the first country and the second country would be paid for the actual services they performed.

The Universal Postal Union has a complex system that administers contracts between member post offices relating to terminal dues paid between and among different post offices. Terminal dues are the payments made between national postal administrations to cover the costs of handling and delivering international mail. Rates are established by the Universal Postal Union and through bilateral and multilateral agreements. Typically, a post office will charge another post office for the delivery of mail to a recipient within its jurisdiction. For instance, if mail is sent from the United States to the United Kingdom, the United States post office will deliver the mail to the Royal Mail, and the Royal Mail will deliver the mail to the recipient. At the end of a predetermined time, the United States post office and the Royal Mail will tabulate, by weight, all of the mail each post office delivered for the other post office and calculate how much money one post office owes to the other post office.

One of the disadvantages of the above procedure is that it does not accurately determine the services performed by each post office.

An additional disadvantage of the prior art is that each post office was not sure that it was receiving the proper amount of money for the services it was performing

A further disadvantage of the prior art is that mail did not have an indication of the value of the services produced by different post offices.

B. APPELLANT'S CLAIMED INVENTION

Appellants claim a method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, that involves the affixing of a radio frequency identification tag to mail for the payment of the carrier fees for the first country; and the second country so that the first country and the second country would be paid for the actual services they performed.

This invention overcomes the disadvantages of the prior art by making it easier for the various post offices to calculate accurately terminal dues by providing information to the post office regarding each piece or parcel of mail that crosses an international border. The invention also makes it easier for the post offices to calculate terminal dues by obtaining fee information from mail that is sent internationally.

The foregoing processes are accomplished by placing an indication on the mail that the fees for delivering the mail have been paid or will be paid by a mailer to each post office who handles the mail. For instance, if a mail piece is mailed in the United States and delivered to a destination in the United Kingdom, the mailer's postage meter will place a Radio Frequency Identification Tag ("RFID") on the mail piece that indicates the portion of the delivery cost that is attributable to the United States post office, and that portion of the delivery cost that is attributable to the Royal Mail.

An advantage of this invention is that it provides more accurate reporting and checking of the amount of international mail. Thus, each post office receives the correct revenue for the amount of mail that it processes.

Claim 1 is the only independent claim in this patent application. Claim 1 is claims a method for paying for mail to be delivered from a sender in a first country to a

recipient in a second country, by affixing a radio frequency identification tag to mail for the payment of the carrier fees for the first country; and the second country.

Appellant's invention is shown in Fig. 2, and paragraph 016 of page 4 to paragraph 023 of page 8. A copy of Fig. 2 appears next to this page.

Fig. 2 is a block diagram illustrating the process of metering international mail so that terminal dues will be paid. Electronic postage meter 130 that contains a RFID read/write head 50 or personal computer meter 131 that contains a read/write head 51 may be used to write a unique number 19 (Fig. 4) and other information into tag 28 (Fig. 1). During a communication between postage meter 130 or personal computer meter 131 with data center 132, it will be indicated that meter 130 or meter 131 wrote information into tag 28 including a unique number 19. The operation of meters 130 and 131 will be described in the description of Fig. 3. Mail records controller 133 will transmit the information it receives from data center 132 to data base 102, where a record is created, specifically referenced to the issued unique number 19 for a particular meter 130 or 131 account number. The record is a proof of validity of tag 28 that issued unique number 19 for a particular meter, and the proof is provided when data base 102 is consulted.

Postal terminal dues processor 140 is coupled to archive 108, national, international and terminal dues data base 141, finance 142 and archives 108 and 113. Processor 140 will poll archive 108 and archives 113 in other lands 111 (United Kingdom, France, German, Japan, etc.) and utilize data base 141 to determine the value of the mail processed by the receiving countries from the sending countries. Then processor 140 will determine how much money each country will receive for delivering mail 21. The amounts of money will be described in the description of Fig. 4. At agreed

upon intervals, finance 142 will issue terminal dues statements to all participating countries and arrange for the transmission of funds to the countries Post Offices.

In step 104, the mail is collected and rated at various post office recording stations using data capture techniques and processed by the accepting post office in step 105. As part of the mail accepting procedures in step 105, the information in tag 28 including unique number 19 are examined and compared to data in data base 102, to determine whether the information in tag 28 and unique number 19 used are legitimate. When unique number 19 is issued for tag 28, the issuance of unique number 19 is reported to the "all issued indicia records national data base" 102, where a record is created, capturing the issued unique number 19 for a particular mailer account number. The record is a proof of validity of postal indicia 20 and 31 having an issued unique number for a particular mailer account number, and the proof is provided when data base 102 is consulted.

In the acceptance process, a code reader is used to identify the unique number 19 and other information recorded in tag 28. The tag 28 and unique number 19 is reported to data base 102, and a proof of validity of tag 28 and unique number 19 is requested. If data base 102 has a record showing the issuance of the unique number 19 for the particular meter account serial number used and that the unique number 19 has not been canceled, then tag 28 is considered legitimate. In that case, tag 28 has passed the verification process, and the mail is accepted for further processing, with tag 28 being canceled in step 105. It is preferred that the cancellation mark be produced with a visible ink and in an electronically readable format in a manner that a "canceled" tag 28 is easily distinguishable from an unused one, and that a "cancelled" postal indicator" will appear on label 29 and in tag 28.

When tag 28 bearing a unique number 19 for a particular user meter account serial number is canceled in step 105, a request is made to data base 102 to alter the record that is specifically related to the unique number 19 being canceled. The altered record will contain the date and time of cancellation, the cost of the selected services derived from the weighing of the mail, and no longer provide a proof of validity when data base 102 is consulted. The cost for mailing the mail determined in step 105 will be charged to the mailer's meter account 130 or 131. The mailer cost information will be transmitted to data center 132 via data base 102 and controller 133.

However, if the acceptance procedures in step 105 fail to yield a proof of validity of tag 28, the mail will be sent to rejected mail process 106 where the mail will be returned to the sender or placed in the dead mail file.

The mail that step 105 determines has legitimate tags 28 are sent to step 107 for internal sorting and routing from place to place. Step 107 will note the date and time the mail is at each step in the process. The foregoing information will be sent to archive 108. Then the physical mail is delivered nationally in step 109 or delivered internationally in step 110. Nationally, at the recipient's delivery post office, the mail will be scanned during the last sorting process where the date and time of sorting as well as other information identifying the mail, i.e., unique number 19, will be captured and stored in archive 108. At the last facility before the mail is transferred internationally in step 110, the mail will be scanned where the date and time of sorting as well as other information identifying the mail, i.e., unique number, will be captured and stored in archive 108.

At this point, the physical mail will be delivered to other lands 111. Then the mail will go to step 112 for sorting, routing and acceptance in the country that the recipient is located. Step 112 will note the date and time the mail is at each step in the process.

The foregoing information will be sent to archive 113. Then the physical mail is delivered nationally in step 114. At the international recipient's delivery post office, the mail will be scanned during the last sorting process where the date and time of sorting as well as other information identifying the mail, i.e., unique number, will be captured and stored in archive 113.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether or not claims 1, 3 – 5 and 9 – 13 are patentable under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).
- B. Whether or not claim 2 is patentable under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).
- C. Whether or not claim 6 is patentable under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).
- E. Whether or not claim 8 is patentable under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).

VII. ARGUMENTS

- A. Claims 1, 3 – 5 and 9 - 13 have been rejected by the Examiner under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).**

The Examiner stated the following in page 2 of the June 30, 2005, Final Rejection: "...Eberhardt discloses a method for paying for mail to be delivered from a sender in a first zip code to a recipient in a second zip code, comprising the steps of: affixing a radio frequency identification (RFID) tag to mail (col. 1, Ins 20-22) for the payment of the carrier fees for the first zip code; and the second zip code (col. 8, Ins 1-13; col. 8, Ins 60-63). Eberhardt, however, is unclear if the payments of the carrier fees apply to a first county; and a second country. Leon, on the other hand incorporates RFID tags affixed to mail that include payment of carrier fees for a first country; and for

a second country (col. 4, Ins 10-18; col 8, Ins 57-67; col 9, Ins 1-12 and 46-52; col 11, Ins 10-12) For example, in columns 8 and 9, Leon discloses payment of carrier fees in the context of an international market. By definition, the term “international” means affecting or relating to two or more nations (i.e., countries). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include payment for a first country and second country on an RFID device so that tracking history of the mail is enhanced.

Eberhardt discloses the following in col. 1, lines 20-22:

“The present application relates to radio frequency identification tags including, but not limited to, a radio frequency identification stamp and mailing label.”

Eberhardt discloses the following in col. 7, lines 67 to column 8, line 13:

“Circuit chip **620** may then be programmed to contain such information as sender, recipient address, delivery service type and billing information. Such information may then be read from circuit chip **620** during article sorting operations permitting automated sorting and automated billing. For example, once mailing label **600** is prepared by circuit chip **620** is programmed, the stored information may be read throughout the delivery operation for routing the associated package to its proper destination. Additionally, upon delivery, the billing instruction is read and the appropriate party invoiced for the services. Should delivery instructions change, circuit chip **620** may be easily reprogrammed with the new delivery information using the same procedures.”

Eberhardt discloses the following in col. 8, lines 60-63:

“The user may input a postage value or a postage value may be automatically calculated, in addition a user may enter at least a zip code and potentially delivery address information.”

Eberhardt discloses a radio frequency identification stamp. Eberhardt does not disclose that the radio frequency stamp may be used for the payment of the carrier fees for the first country; and the second country.

Leon discloses the following in col. 4, lines 8-19:

“Through communications device **160**, host PC **140** is able to communicate with central processing system **120** and postage information system **130**. Host PC **140** and metering device **150** communicate postage information (e.g., registration, funding, and auditing information) with system server **122**, which is part of central processing system **120**. Postal information system **130** is a commercially available system that provides access to national

(and possibly international) postal information such as ZIP codes, rate tables, and other information. Host PC **140** and metering device **150** may communicate with postage information server **130** (i.e., to obtain ZIP code and other information).

Leon discloses the following in col. 8, line 57 to col. 9, line 13:

“The ability to modularize, define, and customize the indicia provides many advantages. With this flexibility, a “standard” metering device can be designed and adopted for use, for example, in an international market. In a specific implementation, a list of available elements is formed for the markets targeted for the device. This list can include information such as the postage amount, graphics, time and date of the indicium creation, creation location, and other pertinent information. A template can be created and stored (e.g., in the SMD or the host PC) for each market (e.g., each country). When an indicium is to be generated, the template is retrieved based on the (country) information entered by the user or the postage system provider. The retrieved template is then “filled” with relevant information from the element list and from inputs provided by the user. A standard metering device can thus be sold and used in various countries, without special modifications.

The flexibility provided by the modular indicia design also allows the metering device to generate different indicia for different classes of mail. Adjustments can be made to the indicia based on, for example, the characteristics of the mail piece, its country of origin, and the like. The flexibility further allows for easy

configuration of the indicia to meet current and future indicia element requirements.”

Leon discloses the following in column 9, lines 42-52:

“In an embodiment, taggants can be added to the ink to provide enhanced security. Taggants are microscopic identifiers (or beads) that can be mixed into the ink (e.g., fluorescent, conventional, or other types of ink), and are not easily detected. Taggants can be included in the ink used by the printer that prints indicia, such as the built-in printer within the metering device, or the ink used to print the preprinted label, or both. Taggants can also be added to the adhesive (i.e., glue) and/or the paper used for the indicium label. Generally, taggants can be added to any and all parts of the indicium.”

Leon discloses the following in column 11, lines 10-21:

“The postage label can also be configured to include an identification device that allows for tracking of the label. One such device is a radio devices frequency identification (RFID) device

disclosed in U.S. Pat. No. 5,497,140, entitled "Electronically Powered Postage Stamp or Mailing or Shipping Label Operative with Radio Frequency (RF) Communication," issued Mar. 5, 1996, and incorporated herein by reference. The RFID device includes an integrated circuit transceiver chip that transmits RF identification signals which can be tracked. Other types of identification devices can also be incorporated into the postage label and is within the scope of the invention."

Leon's disclosure of the ability to modularize, define, and customize the indicia means that, a "standard" metering device can be designed and adopted for use, in an international market, i.e., the metering device may be used in different countries by changing the indicia.

While it is true that Leon's postal information system 130 provides access to national (and possibly international) postal information such as ZIP codes, rate tables, and other information. Leon does not disclose that the radio frequency device may be used for the payment of the carrier fees for a first country; and a second country.

Eberhardt and/or Leon, taken separately or together, do not disclose or anticipate the invention claimed by Appellant. They do not disclose or anticipates affixing a radio frequency identification tag to mail for the payment of the carrier fees for the first country and the second country, for paying for mail to be delivered by a sender in a first country to a recipient in a second country. For instance, if a mail piece is mailed in the United Kingdom, the mailer's postage meter will place a Radio Frequency Identification Tag ("RFID") on the mail piece that indicates the portion of the delivery cost that is attributable to the United States post office, and that portion of other delivery cost that is attributable to the Royal Mail.

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210

(Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

B. Claim 2 has been rejected by the Examiner under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).

Claim 2 is dependent on claim 1. Claim 2 has the following limitation added to the method claimed in claim 1, wherein: the radio frequency tag has a first portion for storing fees for the first country and a second portion for storing fees for the second country.

The Examiner stated the following in Page 3, of the June 30, 2005, Final Rejection:

For claim 2, Eberhardt discloses the RFID tag has a first portion for storing fees for the first zip code and a second portion for storing fees for the second zip code (col 8, lns 1-13, 3-48, and 57-63). It is well known that sender and recipient addresses include a first zip code and a second zip code, respectively; however, Eberhardt does not disclose that fees apply to a first country; and a second country. Leon, however, does disclose storing fees relevant to a first and second country (col 4, lns 14-19; col 8, lns 57-67; col 9, lns 1-13). It would have been obvious to store fees pertaining to different countries on the RFID tag so that payment adjustments are updated in the event of currency rate changes.

Eberhardt discloses the following in col. 7, lines 67 to column 8, line 13:

"Circuit chip **620** may then be programmed to contain such information as sender, recipient address, delivery service type and billing information. Such information may then be read from circuit chip **620** during article sorting operations permitting automated sorting and automated billing. For example, once mailing label **600**

is prepared by circuit chip **620** is programmed, the stored information may be read throughout the delivery operation for routing the associated package to its proper destination. Additionally, upon delivery, the billing instruction is read and the appropriate party invoiced for the services. Should delivery instructions change, circuit chip **620** may be easily reprogrammed with the new delivery information using the same procedures.”

Eberhardt discloses the following in col. 8, lines 43-48:

“Sorting apparatus **100** also includes a controller **101** coupled to exiter/reader station **102**, to which the read signal is communicated, and the controller **101** determines if a proper postage value is present and, if a zip code is programmed, directs package **108** along one of the diverter paths **106** accordingly.”

Eberhardt discloses the following in col. 8, lines 60-63:

“The user may input a postage value or a postage value may be automatically calculated, in addition a user may enter at least a zip code and potentially delivery address information.”

Eberhardt discloses a radio frequency identification stamp. Eberhardt does not disclose that the radio frequency stamp may be used for the payment of the carrier fees for the first country; and the second country, wherein: the radio frequency tag has a first portion for storing fees for the first country and a second portion for storing fees for the second country.

Leon discloses the following in col. 4, lines 8-19:

“Through communications device **160**, host PC **140** is able to communicate with central processing system **120** and postage information system **130**. Host PC **140** and metering device **150** communicate postage information (e.g., registration, funding, and auditing information) with system server **122**, which is part of central processing system **120**. Postal information system **130** is a commercially available system that provides access to national (and possibly international) postal information such as ZIP codes, rate tables, and other information. Host PC **140** and metering device **150** may communicate with postage information server **130** (i.e., to obtain ZIP code and other information).

Leon discloses the following in col. 8, line 57 to col. 9, line 13:

“The ability to modularize, define, and customize the indicia provides many advantages. With this flexibility, a “standard” metering device can be designed and adopted for use, for example, in an international market. In a specific implementation, a list of available elements is formed for the markets targeted for the device. This list can include information such as the postage amount, graphics, time and date of the indicium creation, creation location, and other pertinent information. A template can be created and stored (e.g., in the SMD or the host PC) for each market (e.g., each country). When an indicium is to be generated, the template is retrieved based on the (country) information entered by the user or the postage system provider. The retrieved template is then “filled” with relevant information from the element list and from inputs provided by the user. A standard metering device can thus be sold and used in various countries, without special modifications.

The flexibility provided by the modular indicia design also allows the metering device to generate different indicia for different classes of mail. Adjustments can be made to the indicia based on, for example, the characteristics of the mail piece, its country of origin, and the like. The flexibility further allows for easy

configuration of the indicia to meet current and future indicia element requirements.”

Leon discloses a Postal information system 130 that provides access to national (and possibly international) postal information such as ZIP codes, rate tables, and other information. A rate table is a table that indicates a Post Offices rates for different services and classes of mail, i.e., certified mail, express mail, first class mail, etc. Leon does not disclose that the payment of the carrier fees for the first country; and the second country, are stored in a radio frequency identification tag that has a first portion for storing fees for the first country and a second portion for storing fees for the second country.

When the Examiner stated in Page 3 of the Final Rejection, that “It would have been obvious to store fees pertaining to different countries on the RFID tag so that payment adjustments are updated in the event of currency rate changes”, the Examiner is missing the point of the claimed invention. Namely, a radio identification tag is

affixing to mail for the payment of the carrier fees for a first country and a second country, for paying for mail to be delivered by a sender in a first country to a recipient in a second country, wherein the monies paid to the first country are stored in a first portion of a RFID tag and the monies paid to the second country are stored in a second portion of a RFID tag.

The foregoing is done to improve the Universal Postal Union terminal dues system for the payments made between national postal administrations to cover the costs of handling and delivering international mail. For instance, if mail is sent from the United States to the United Kingdom, the United States post office will deliver the mail to the Royal Mail, and the Royal Mail will deliver the mail to the recipient. At the end of a predetermined time, the United States post office and the Royal Mail will tabulate, by weight, all of the mail each post office delivered for the other post office and calculate how much money one post office owes to the other post office. Appellant's claimed invention indicates the fees that are paid for the delivery of a individual mail piece to a first country in a first portion of a RFID tag and the monies paid to the second country in a second portion of a RFID tag. Appellant's claimed invention eliminates the need for terminal dues meetings, since the first country and the second country are paid for the delivery of each piece of mail shortly after a RFID tag is affixed to the mail.

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re*

Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); **in re Deuel**, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); **in re Fritch**, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. ***In re Ochiai***, supra; **in re Vaeck**, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); **in re Fine**, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); **in re Dow Chemical Co.**, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

C. Claim 6 has been rejected by the Examiner under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).

Claim 6 is dependent on claim 4 and claim 4 is dependent on claim 1.

Claim 4 has the following added to the method claimed in claim 1, wherein, human readable information is printed in the vicinity of the radio frequency identification tag.

Claim 6 has the following added to the method claimed in claim 4, wherein the human-readable information indicates that postage has been canceled. In addition to the arguments made in above Section A, please consider the following.

The Examiner stated the following in page 3 of the June 30, 2005, Final Rejection: "For claim 6, Eberhardt discloses human readable information that indicates that the postage has been canceled (col 8, lines 49-54)"

Additionally, sorting apparatus **100** may be adapted to provide a data signal **116** to stamp **10**. The data signal may contain additional stored information to be retained in circuit chip **20**, such as additional tracking and routing information, and may also provide data canceling the postage value, i.e., canceling stamp.

Eberhardt discloses that a data signal may contain additional stored information that is retained in circuit chip 20, such as data canceling the postage value, i.e.,

canceling stamp 10. Eberhardt does not disclose that the canceling information is in human readable form.

D. Claim 8 has been rejected by the Examiner under 35 U.S.C. §103(a) over Eberhardt et al. (U.S. 6,130,613) and further in view of Leon (U.S. 6,701,304).

Claim 8 is dependent on claim 1.

Claim 8 has the following added to the method claimed in claim 1, wherein the radio frequency tag contains a unique number that uniquely defines the mail.

In addition to the arguments made in above Sections A, please consider the following.

The Examiner stated the following in page 3 of the June 30, 2005, Final Rejection: "For claim 8, the RFID tag contains a unique number that uniquely defines the mail (col 3, lns 18 – 20; col 4, lns 53 – 55)."

Eberhardt discloses the following in col 3, lines 18 – 27:

In accordance with preferred embodiments of the present invention and with reference to FIG. 1 and FIG. 2, a radio frequency identification stamp ("stamp") **10** is formed by printing on a first surface **12** of a substrate **24** indicia **14** indicative of at least a postage value. An antenna **16** is formed on a second surface **18** and a radio frequency identification circuit chip ("circuit chip") **20** is secured to second surface **18** and coupled to the antenna **16**. A layer **22** of adhesive, shown in phantom in FIG. 2 to better illustrate antenna **16** and circuit chip **20**, is also disposed on second surface **18**.

Eberhardt discloses the following in col 4, lines 53 – 55:

Data signal **116** may contain additional stored information to be retained in circuit chip **20**, such as additional tracking and routing information, and may also provide data canceling the postage value, i.e., canceling stamp **10**.

The foregoing does not disclose a unique number. A unique number will uniquely define each piece of mail so that it may be positively identified from every other piece of mail.

PRAYER FOR RELIEF

In view of the above, Appellants respectfully submit that appealed claims 1-6 and 8-13 in this application are patentable. It is requested that the Board of Appeal overrule the Examiner and direct allowance of the rejected claims.

Respectfully submitted,



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X. Appendix of Claims Involved In The Appeal

1. A method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, comprising the steps of:

affixing a radio frequency identification tag to mail for the payment of the carrier fees for the first country; and the second country.

2. The method claimed in claim 1, wherein: the radio frequency tag has a first portion for storing fees for the first country and a second portion for storing fees for the second country.

3. The method claimed in claim 1, wherein: one or more graphics are printed in the vicinity of the radio frequency identification tag.

4. The method claimed in claim 1, wherein: human readable information is printed in the vicinity of the radio frequency identification tag.

5. The method claimed in claim 4, wherein the human-readable information indicates postage has been paid.

6. The method claimed in claim 4, wherein the human-readable information indicates that postage has been canceled.

7. (canceled)

8. The method claimed in claim 1, wherein the radio frequency tag contains a unique number that uniquely defines the mail.

9. The method claimed in claim 1, wherein the radio frequency identification tag stores the services requested by the mailer.

10. The method claimed in claim 9, wherein the radio frequency identification tag stores the payment for the requested services.

11. The method claimed in claim 1, wherein the radio frequency identification tag stores the mailer's name and address.

12. The method claimed in claim 1, wherein the radio frequency identification tag stores the recipient's name and address.

13. The method claimed in claim 1, further including the step of canceling the radio frequency tag.

IX. EVIDENCE APPENDIX

There is no additional evidence to submit.

X. RELATED PROCEEDING APPENDIX

There are no related appeals or interferences that may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

CERTIFICATE OF MAILING

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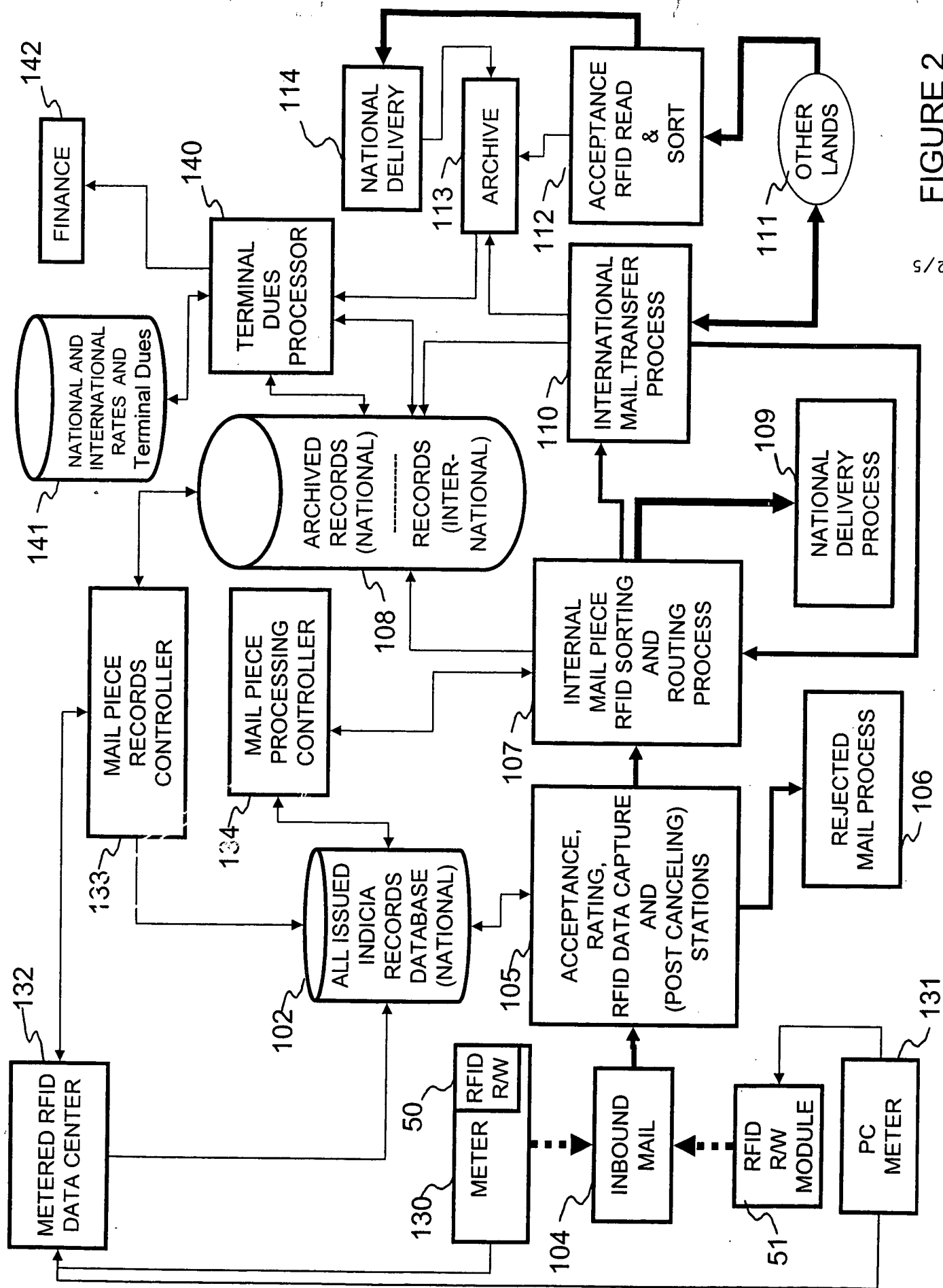


FIGURE 2